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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.                | CONFIRMATION NO.       |
|--|-------------|----------------------|------------------------------------|------------------------|
| 10/731,623   | 12/08/2003  | Srinivasulu Puri     | 021756-005300US                    | 8904                   |
| 51206 7590 10/25/2007<br>TOWNSEND AND TOWNSEND AND CREW LLP<br>TWO EMBARCADERO CENTER<br>8TH FLOOR<br>SAN FRANCISCO, CA 94111-3834 |             |                      | EXAMINER<br>CERVETTI, DAVID GARCIA |                        |
|  |             |                      | ART UNIT<br>2136                   | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>10/25/2007            | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/731,623

**Applicant(s)**

PURI ET AL.

**Examiner**

David G. Cervetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/18/07</u> .   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. Applicant's arguments filed August 15, 2007, have been fully considered but they are not persuasive.
2. Claims 1-24 are pending and have been examined.

***Response to Amendment***

3. The objection to the specification is withdrawn.
4. The objections to claims 6, 7, 8, 16, 17, 23, and 24 are withdrawn.
5. The rejection of claims 20-24 under 35 U.S.C. 101 is withdrawn.
6. Regarding the double patenting rejection (copending Application No. 10/731,299), Examiner respectfully submits that it still determines if a signature is needed and collects it, it is irrelevant if the signature is **to approve an electronic record** (Emphasis added) or anything else, such language pertains only to usage. It is further submitted that as the claims stand, claim 1 of the instant application is capable of performing what claim 1 of application 299 claims, therefore they are not patently distinct from the copending application claims and as such are unpatentable for obvious-type double patenting.
7. Regarding the double patenting rejection (copending Application No. 10/731,655), Examiner respectfully submits the same argument as before. It is still determining whether a signature is needed to commit a transaction, as claim 1 of application 655 claims. The difference is that the instant application recites such feature in the preamble, while copending application 655 recites such feature as a limitation (a step of the method).

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8. Applicant's arguments are not persuasive.

9. Regarding the prior art argument, Examiner respectfully submits that SmarTeam provides the tracking mechanism, the workflow process to sign a document, and an approval function that implements the signing process, the API is inherent to how software works, the approval function facilitates the signing process, receives input, produces output, the approval function interacts with the database and the server, thus has an application program interface. It is respectfully not clear what Applicant is trying to argue, while it is true that the elements must be arranged as required by the claim, this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01.

10. Regarding the determining if a signature is needed, Examiner respectfully submits that assuming *arguendo* SmarTeam teaches none of the claim limitations as argued by Applicant (page 13), Applicant appears to admit that SmarTeam does in fact, at the very least, provide the architecture to implement the invention (page 14, signing a record does not necessarily teach ..). SmarTeam teaches compliance with the FDA rule as correctly admitted by Applicant (page 14) using digital signatures (electronic records and electronic signatures, Introduction, section 2.3), just as the claim language attempts to do (determining if a signature is needed to commit a transaction based on a triggering event).

11. Regarding the argument that SmarTeam allegedly does not teach if execution of the rule results in a determination that an electronic signature is required for the transaction, instantiating a signature collection process (**sec. 2.2-2.3**). Examiner respectfully points to the cited section, and submits that the signature collection process is the signing using the user's signature as recited in the cited portion. Applicant's arguments are not persuasive.

***Specification***

12. The disclosure is objected to because of the following informalities: "application No. 10/371,655", perhaps "10/731,655" was intended. Appropriate correction is required.

***Double Patenting***

13. Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. **10/731,299**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the triggering found in the instant application is analogous to the event of the copending one and both use such trigger to determine whether a digital signature is needed to perform a transaction (commit).

14. Claims 1-25 of copending Application No. **10/731,299** contain every element of claims 1-24 of the instant application and thus anticipate the claims of the instant application. Claims 1-24 of the instant application therefore are not patently distinct from the copending application claims and as such are unpatentable for obvious-type double

patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

15. Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. **10/731,655**. Although the conflicting claims are not identical, they are not patentably distinct from each other because both use a trigger to determine whether a digital signature is needed to perform a transaction (commit).

16. Claims 1-26 of copending Application No. **10/731,655** contain every element of claims 1-24 of the instant application and thus anticipate the claims of the instant application. Claims 1-24 of the instant application therefore are not patently distinct from the copending application claims and as such are unpatentable for obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

17. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species with that genus). "ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

18. "Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "anticipated" by the species of the patented invention. Cf., *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic claim. *In re Van Ornum*, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); *Schneller*, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting." (*In re Goodman* (CA FC) 29 USPQ2d 2010 (12/3/1993))

***Claim Rejections - 35 USC § 102***

19. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**20. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by SmartTeam (NPL "SmarTeam™ FDA Compliance Technical Paper Functional Compliance With FDA Rule 21 CFR Part 11").**

Regarding claims 1 and 20, SmartTeam teaches a method of intercepting a transaction instantiated by a database application to determine if an electronic signature is necessary to commit the transaction to the database, the method comprising / A computer program product having a computer-readable storage medium storing a set of code modules which when executed by a processor of a computer system cause the processor to intercept a transaction instantiated by a database application to determine

if an electronic signature is necessary to commit the transaction to the database

**(sections 1 – introduction - , 2.2-2.3)**, the computer program product comprising:

- in response to a triggering action generated by the database application, calling an application program interface to raise an event **(sec. 2.2)**;
- initiating a workflow process that executes a rule to determine if an electronic signature is required to approve the transaction **(sec. 2.2)**; and
- if execution of the rule results in a determination that an electronic signature is required for the transaction, instantiating a signature collection process **(sec. 2.2-2.3)**.

**Regarding claim 11**, SmartTeam teaches a computer system **(sec. 2.1)**

comprising:

- a processor; a database; and a computer-readable memory coupled to the processor, the computer-readable memory configured to store a computer program **(sec. 2.1)**;
- wherein the processor is operative with the computer program to:
  - o (i) call an application program interface to raise an event in response to a triggering action generated by the database application **(sec. 2.2)**;
  - o (ii) initiate a workflow process that executes a rule to determine if an electronic signature is required to approve the transaction **(sec. 2.2)**;and



- (iii) instantiate a signature collection process if execution of the rule results in a determination that an electronic signature is required for the transaction **(sec. 2.2-2.3)**.

**Regarding claims 2 and 12**, SmartTeam teaches wherein the application program interface comprises an event name and an event id **(sec. 2.2-2.3)**.

**Regarding claims 3 and 13**, SmartTeam teaches wherein the signature collection process can be either a synchronous collection process or an asynchronous collection process **(sec. 2.2, 2.4)**.

**Regarding claim 4**, SmartTeam teaches wherein the application program interface comprises an event name, an event id and an indication of whether the signature collection process is a synchronous process or an asynchronous process **(sec. 2.2-2.4)**.

**Regarding claims 5, 14, and 21**, SmartTeam teaches wherein the workflow process generates an electronic record that captures data associated with the transaction **(sec. 2.2)**.

**Regarding claims 6, 15, and 22**, SmartTeam teaches wherein the electronic record comprises unstructured data **(sec. 2.1)**.

**Regarding claims 7, 16, and 23**, SmartTeam teaches wherein the unstructured data comprises extensible markup language data stored in character large object (CLOB) format **(sec. 2.1)**.

**Regarding claims 8, 17, and 24**, SmartTeam teaches wherein the extensible markup language data comprises a first well-formed extensible markup language

document that comprises extensible markup language fields generated from a mapping to fields in a database and a second well-formed extensible markup language document that comprises the electronic record as it is displayed to a user during the signature collection process (**sec. 2.2-2.4**).

**Regarding claims 9 and 18**, SmartTeam teaches obtaining an electronic signature in response to the signature collection process; and thereafter, verifying the electronic signature and, if the electronic signature is verified, updating a field of the electronic record to indicate a valid signature was received (**sec. 2.2-2.3**).

**Regarding claims 10 and 19**, SmartTeam teaches committing the transaction to the database if the electronic signature is verified (**sec. 2.2**).

### ***Conclusion***

21. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. NPLs provided teach using XML and digital signatures to provide for audit trail in a database system, Gladney (US Patent Application Publication 2003/0131241) teaches digital document interchange using digital signatures and binding signatures to data object when updates occur, Markowitz et al. (US Patent Application Publication 2003/0009295) teaches a laboratory information management

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system using XML and digital signatures, Kung (US Patent Application Publication 2003/0196108) teaches binding information objects to security labels, XML, and audit system.

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Cervetti whose telephone number is (571)272-5861. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on (571)272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David García Cervetti/

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10,23,07